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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,921	03/10/2004	Richard Dick	15587.4	6824
21999 7590 01/24/2008 KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111			EXAMINER CERVETTI, DAVID GARCIA	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 01/24/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

AKK

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/799,921	DICK, RICHARD	
	<b>Examiner</b>	<b>Art Unit</b>	
	David García Cervetti	2136	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/01/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's arguments filed October 24, 2007, have been fully considered.
2. Claims 1-20 are pending and have been examined.

### ***Response to Amendment***

3. The objections to claims 1, 6, 7, 8, 12, and 13 are withdrawn.
4. Regarding the Double Patenting arguments, Examiner respectfully submits that the Office Action provided an analysis of the claims to support the rejection. Furthermore, the language of the patent is more specific than that of the instant application and therefore the claims are not patentably distinct. The arguments are not persuasive.

5. Regarding Applicant's argument that Adams fails to teach certain features, Examiner respectfully submits that the cited portions teach reviewing/ editing/ modifying/ correcting profiles, as further explained in the cited portion and pars. 102-109. Applicant's arguments are not persuasive.

### ***Claim Objections***

6. Claims 1 and 14 are objected to because of the following informalities:  
"enterprise/server". . .Appropriate correction is required.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-

type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321 (d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**9. Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,804,787.**

10. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1-13 correspond to the

claims 1-19 of the patent claims and encompass the scope of claims 1-13 of the instant application.

11. The instant application generally claims

a method for controlling a release of personal information. Patent 6,804,787 claims similar limitations except "health information", "a requester", "patient", "a single point entry/exit", and "request electronically authenticated to be authorized by the patient".

12. However the instant application claims equivalent words/limitations: "personal information", "organizations", "individual", "enterprise/server", and "to not release information ... without receiving authorization from said individual", respectively.

13. They are equivalent because in the instant application page 19 lines 4 discloses personal information including medical records. Page 19 paragraph 3-page 20 paragraph 2 discloses a requester being a medical organization. Fig. 2 discloses a user 100 that is patient to medical organizations 106 and/or third party insurance company 112. On page 20 paragraph 1, disclosed each of the organization contractually agrees to first contact enterprise/server 102 before releasing any information about the user so the server 102 can inform and request the user 100 if request to release confidential information is acceptable or not. On page 10 paragraph 2 the instant application discloses member/user/patient receiving an electronic alert, such as email, when information about the member is accessed or requested and on page 20 paragraph 1 disclosed when confidential information request is received the user must be contacted before releasing access.

14. Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitation of the instant application.

15. Claims of the instant application therefore are not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting (In' re Goodman (CAFC) 29 USPQ2D 2010 (13/3/1993)).

**16. Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-24 of copending Application No. 11057097.**

17. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1-13 correspond to the claims of the copending claims and encompass the scope of claims 1-13 of the instant application.

18. The instant application generally claims a method for controlling a release of personal information.

19. Copending application 11057097 claims similar limitations except "if the requested information is not subject to the requirement, releasing the requested information to the requestor". However, Copending application claims, "determining whether the consent of the individual has been obtained, wherein the releasing of the requested information to the requestor is performed ...if the consent of the individual has been obtained when the consent is required", which is equivalent to the instant application.

20. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

21. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

22. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Receiving a disclosure or a contractual agreement from said organizations was not described.

23. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

24. Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the trademark WebCrawler in these claims renders the claims indefinite. Perhaps "web crawler" was intended. Appropriate correction is required.

25. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



The use of Internet in these claims renders the claims indefinite. Perhaps "internet" or "network" was intended. "Internet" capitalized appears to refer only to the public network as opposed to a local or wide area network. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

27. **Claims 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bjorksten et al (US Patent Application Publication 2003/0097451, hereinafter Bjorksten).**

**Regarding claim 15, Bjorksten teaches**

a method for creating and sharing a database of verified personal information comprising **(abstract):**

automatically gathering information regarding an individual from a plurality of information sources over a wide area computer network **(par. 46);**

presenting said information and the sources of said information over the wide area computer network to said individual to review and verify said information's accuracy **(par. 40-41);**



accepting commentary on the accuracy of said information based on said review from said individual over the wide area computer network (**par. 40-41**);

including said commentary in said database with said information (**par. 41-44**);

receiving a request over said wide area computer network from an authorized individual to review selected portions of said information (**par. 40**);

presenting said request to said individual for authorization (**par. 40-41**);

presenting said selected portions of said information over said wide area computer network to said authorized individual along with identification of said sources of said selected portions of said information and any commentary on the accuracy of said selected portions of said information provided by said individual (**par. 39-42**); and providing access to said database and said commentary to third parties (**par. 41-46**).

**Regarding claim 16**, Bjorksten teaches

supplementing said information regarding the individual by a continuous gathering process (**par. 41-46**);

notifying said individual of updates to said information located by said continuous gathering process (**par. 45-48**); and

accepting further commentary on the accuracy of said updates to said information from said individual over the wide area computer network (**par. 45-49**).

**Regarding claim 17**, Bjorksten teaches receiving a search of said database from a third party that results in information about said individual being displayed to said third party; and notifying said individual of said search and said display (**par. 61-64**).

**Regarding claim 18**, Bjorksten teaches receiving additional information from said individual over the wide area computer network (**par. 61-64**); and receiving a designation from said individual designating said additional information as one of: information to be made available to all subscribers of said database; and information to be released only upon specific authorization of said individual (**par. 40-42, 61-64**).

**Regarding claim 19**, Bjorksten teaches wherein the commentary on the accuracy of said information comprises an indication that a portion of said information is incorrectly associated with said individual (**par. 67-70**).

**Regarding claim 20**, Bjorksten teaches requiring said third parties to register with said database and present said database with identifying information prior to providing access to said database and to said commentary to said third parties (**par. 36-38, 96-98**).

***Claim Rejections - 35 USC § 103***

28. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

29. **Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton USPN 7,028,049 B1 in view of Coleman PG Pub 2004/0139025 A1.**

**Regarding claim 1**, Shelton discloses

a method for controlling a release of personal information (**col. 4 lines 53-58, col. 8 lines 1-4, col. 3 lines 44-col. 4 lines 24 and col. 16 lines 32-63; controlling release of patient's confidential medical records by requiring patient's authorization anytime access is requested**) comprising:

depositing some personal information regarding an individual with an enterprise/server (col. 3 lines 66-col. 4 lines 2, col. 9 lines 40-45, col. 5 lines 1-9 and fig. 1 elements 13 and 21; plurality of patients medical data stored in a database);

organizations (col. 9 lines 9-18, col. 9 lines 57-63, and fig. 1 elements 10a-c; health care info. users are clients, hospitals, doctors, nursing services, insurance companies...) that possess additional personal information regarding said individual to not disclose that additional personal information without authorization from said enterprise/server (col. 7 lines 40-50, col. 10 lines 18-36, col. 9 lines 1-8, and col. 10 lines 53-col. 11 lines 45; physicians insurance companies 10b requiring patients confidential info. to be shared with authorized third-parties and server 12, approval agent 16 requesting patient's approval first., no medical document of the patient's is provided without patient's consent); and

instructing said enterprise/server to not release said some personal information held on the enterprise/server and to not authorize release of said additional personal information at the organizations without receiving authorization from said individual (col. 11 lines 32-45, col. 8 lines 1-4; server 12~approval agent 16 is instructed not to release any patient's medical records stored in the database 21 and indexed in a master index 13 without first requesting patient's approval for release).

Shelton is silent about obligating organizations that possess personal information regarding said individual to not disclose that information without authorization from said enterprise/server.

However, Coleman discloses a method of controlling and/or protecting the privacy of individuals' personal information (**see abstract and fig. 2 element 420; protecting personal medical record) by obligating(col. 0041) entities (merchant, insurance companies, see par. 0030) to protect individuals' personal information (0056-0059 and fig. 3)** and providing individual generated restrictive notice to obligate entities (**par. 0031, 0056-0059**), wherein said protect including obligation to entities not to share, transfer, and sell personal information to other entities (**par. 0027, 0059, and 0061**).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Coleman within the system of Shelton because they are analogous in protecting personal confidential data. One would have been motivated to incorporate the teachings, of obligating organizations/entities not to disclose individuals' confidential data, because it would restrict the organization/entities from sharing or transferring individuals confidential information without individual's permission.

**Regarding claim 2**, Shelton discloses the method, wherein said enterprise/server is Internet- accessible (**col. 9 lines 19-32 and lines 41-45**).

**Regarding claim 3**, Shelton discloses the method, further comprising using WebCrawler programs to locate and retrieve publicly-available information regarding said individual from a plurality of Internet-accessible sources (**col 16 lines 64-col. 17 lines 12; web robot**).

**Regarding claim 4**, Shelton discloses the method wherein said individual is a member of a database service (**col. 3 lines 66-col. 4 lines 2, col. 9 lines 40-45, col. 5 lines 1-9 and fig. 1 elements 13 and 21**).

**Regarding claim 5**, Shelton discloses the method wherein said personal information comprises database entries (**col. 3 lines 66- col. 4 lines 2, and fig. 1 elements 13 and 21**).

**Regarding claim 6**, Shelton discloses the method wherein said obligated organizations are subscribers to a database service (**col. 9 lines 57-col. 10 lines 4 and col. 5 lines 33-35**).

**30. Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton USPN 7,028,049 B1 in view of Adams et al. PG Pubs 2002/0013519 A1.**

**Regarding claim 7**, Shelton discloses a method for creating a database of verified personal information (**col. 4 lines 53-58, col. 8 lines 1-4, col. 3 lines 44-col. 4 lines 24 and col. 16 lines 32-63; controlling release of patient's confidential medical records of database 21 master index 13 by requiring patient 's verifying anytime access is requested**) comprising:

**gathering information regarding an individual (patient)(col. 3 lines 66-col. 4 lines 2, col. 9 lines 40-45, col. 5 lines 1-9 and fig. 1 elements 13 and 21; plurality of patients medical data stored in a database);**

**receiving a request over said wide area computer network (WAN see col. 9 lines 1-8) from an authorized individual (physicians/insurance companies 10b) to review**

selected portions of said information (**col. 9 lines 57-col. 10 lines 36, and col. 10 lines 53-col. 11 lines 45; physicians/insurance companies 10b requesting patients confidential info.**);

presenting said request to said individual (patient) for authorization (**col. 11 lines 31-45, col. 8 lines 1-4, and col. 10 lines 53-col. 11 lines 20; server 12 approval agent 16 indicating/presenting that a request has been made for the records selected by the requesting client 10 to the patient for authorization**);

presenting said selected portions (**patient history, comprehensive medical records, lab reports, test results, prescription drug records...**, see **col. 7 lines 5-12**) of said information over said wide area computer network to said authorized individual (**physicians/insurance companies 10b**) (**col. 16 lines 32-63, col. 11 lines 4-53, col. 10 lines 18-35, and col. 7 lines 40-50**); and

providing access to said database and said commentary (**patient consent/evidentiary documentation of the propriety**) to third parties (**insurance company/other doctor**) (**col. 7 lines 40-50, col. 6 lines 12-15, and col. 16 lines 32-63**).

Shelton discloses presenting request to patients' medical record by email/fax. Shelton is silent regarding presenting said information over a wide area computer network to said individual (patient) to review and verify said information's accuracy; accepting commentary on the accuracy of said information based on said review from said individual over the wide area computer network; and including said commentary in a database with said information.

However Adams et al. discloses a secure patient test result delivery system (**see abstract**). Patient is presented information over a wide area computer network (**par. 0015-0016**) to review and verify and information's accuracy (**par. 0085, 0095, 0109; patient logging online and editing patient database 560, that contain name, unique ID, phone number, address .... and editing to allow release of her/his information to physicians**); patient accepting commentary (**checking release box, pars. 102-109**) on the accuracy of said information based on said review from said individual over the wide area computer network (**par. 0118; patient checking a medical release box via network for review by physicians**) and including said commentary in said database with said information (**0085, 0095, 0109 and 0118**).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Adams et al. within the system of Shelton because they are analogous in patient medical data protection by requiring patients approval. One would have been motivated to do so because a patient would review and verify his/her information for editing/upgrading current info. and allowing or denying access to physicians.

**Regarding claim 8**, Shelton discloses wherein said wide area computer network is an Internet (**col. 9 lines 19-32 and lines 41-45**).

**Regarding claim 9**, Shelton discloses wherein said the step of gathering information further comprises using WebCrawler programs to locate and retrieve



publicly- available information regarding said individual individuals from a plurality of Internet-accessible sources (col. 16 lines 64-col. 17 lines 12; webrobot).

Regarding claim 10, Shelton discloses wherein said individual is a member of a database service (Shelton col. 3 lines 66-col. 4 lines 2, col. 9 lines 40-45, col. 5 lines 1-9 and fig. 1 elements 13 and 21).

Regarding claim 11, Shelton discloses the method wherein said selected portions of said information and said information are database entries related to said individual (col. 13 lines 41- col. 14 lines 10, col. 10 lines 6-11, and fig. 1 element 21; indexing and/or storing patient medical record .... Social security number, and name).

Regarding claim 12, Shelton discloses wherein said third parties are subscribers to a database service (col. 7 lines 40-50).

Regarding claim 13, Shelton discloses wherein said authorized individuals are members of a database service (col.9 lines 57-col. 10 lines 4 and col. 5 lines 33-35).

### **Conclusion**

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David García Cervetti whose telephone number is (571)272-5861. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David García Cervetti/

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1, 20, 08